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10/016,990	12/14/2001	Stevan A. Koistinen	21-1231	4975

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EXAMINER

WEINHOLD, INGRID M

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/016,990

Applicant(s)

KOISTINEN, STEVAN A.

Examiner

Ingrid M Weinhold

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-8,10,17,18,20-22 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 and 18 is/are allowed.
- 6) ☒ Claim(s) 1,2,6-8,10,20 and 25-29 is/are rejected.
- 7) ☒ Claim(s) 21, 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not discuss that the mounting portion has a uniform width and a uniform thickness. In fact, most of the drawings of the mounting portion show this not to be true, such as Figure 6, which is the figure that shows the end extents perpendicular to the longitudinal extent.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 25 and 27, there is no antecedent basis for "the securing arm".

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 7, 8, 10, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waddell (5,215,236) in view of Walker et al. (4,928,864). Waddell shows a clip comprising a mounting portion having an inner face and an opposing outer face, a pair of side edges and a pair of end edges, an elongate longitudinal extent (21), a pair of transverse extents, each transverse extent extending from one of the end regions of the longitudinal extent in a generally transverse orientation to the longitudinal extent, a pair of return extents, each of the return extents extending from one of the transverse extents, each of the return extents extending towards each other, and a pair of free end extents, each of the free end extents extending from one of the return extents. The pair of transverse extents extend outwardly from the inner face of the longitudinal extent (21), each of the transverse extents having opposite end regions, a first one of the end regions of each of the transverse extents being joined to one of the end regions of the longitudinal extent. Each of the return extents extends generally parallel to the longitudinal extent, and extends from a second one of the end regions of one of the transverse extents. Each of the transverse extents and each of the return

extents are arcuate. The end edges of the mounting portion are located on one of the free end extents and a gap is formed between the end edge on the free end extent and the longitudinal extent. The clip additionally comprises a securing portion mounted on the mounting portion comprising a hook (25) for holding a portion of an ornamental item against the mounting portion, the hook having a first end mounted on the mounting portion and a second end being free of connection to the mounting portion, the hook opening toward a side edge of the mounting portion and extending substantially parallel to the longitudinal extent and substantially perpendicular to the side edge of the mounting portion. The hook generally converges toward and is biased against the outer face at the second end to form a channel for receiving a portion of the ornamental item. The securing arm extends past one of the side edges of the mounting portion, as best seen in Figure 3 on the right-hand side. Waddell does not however show the free end extents being arcuate in a direction that allows the group of connected transverse, return and free end extents forming a portion of a circle and does not specifically show the distance of the gap being approximately one-half the distance of a farthest extent of the return extents from the longitudinal extent. However, Walker et al. does show the free end extents (13) being arcuate as to form a portion of a circle with the transverse and return extents. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have created the end extents by Waddell arcuate in the direction as taught by Walker in order to allow the mounting portion to fit more securely onto the palm of the user. It is inherent that the extents need to be able to flex significantly enough for the clip to be placed onto a user's hand. Therefore it

would have been obvious to one of ordinary skill in the art at the time the invention was made to have the extents flex to approximately twice the original distance to allow the clip to be placed onto the user's hand.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waddell (5,215,236) in view of DesSaulles (2,506,859). Waddell shows all features claimed by the applicant's invention but does not however show the free end extents being arcuate in a direction that allows the group of connected transverse, return and free end extents to form a portion of a circle or the free end extents being oriented generally perpendicular to the longitudinal extent. DesSaulles shows the mounting portion overlapping itself with the free end extents (24,26) being arcuate as to form a portion of a circle with the transverse and return extents and oriented generally perpendicular to the longitudinal extent. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have created the mounting portion of Waddell as taught by DesSaulles to allow a more secure fit onto a user's hand.

***Allowable Subject Matter***

Claims 17, 18 are allowed. The prior art, alone or in combination, does not show all the features of the mounting portion as claimed in combination with a securing portion having two ends, a first end mounted adjacent a first edge of the mounting portion and a second end free of connection and extending past a second edge of the mounting portion.

Claims 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 25-28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant argues with respect to the Walker reference and the DesSaulles reference that the end portions would dig into a user's hand if the extents formed a portion of a circle. A portion of a circle only signifies that the extent needs to be arcuate and smooth and does not specify how much of the circle is created, therefore with reference to the extents by Walker, the ends would only press against a users hand enough to keep it in place, and not enough to "dig" into a user's hand. The mounting portion of DesSaulles would actually be more comfortable since the mounting portion overlaps itself and the end portions do not dig into the users hand at all.

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Regarding the applicant's argument based on Claim 17, this argument is moot since claim 17 has now been allowed.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ingrid M Weinhold whose telephone number is 703-306-5762. The examiner can normally be reached on 5:30 AM - 2:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on 703-308-2156. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DW

Ingrid Weinhold  
Patent Examiner  
Art Unit 3632

  
Korie Chan  
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